

DETAILED ACTION

Claim Objection

Claim 52 is objected for its claim language. "Operable to" should be changed to "configured to".

Claim Rejection – USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 25-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, in the independent claims of the present application, it is recited that "cross-reference file" is acquired from either the paying bank or the capture bank or both. However, according to paragraph 0032 of the present application, the cross-reference file is received from the paying bank only.

Claim Rejection – USC 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 25-36 fail to meet the above requirements since there is not a sufficient tie to another statutory class. Simply stating a method is computer implemented in the preamble is not sufficient to establish a tie to a statutory class. In addition, the procedure which is tie to another statutory class must be more than insignificant "extra solution" activity. Examiner suggests that applicants add some hardware which executes the claimed steps, such as a computer or a computer processor, to the claim language.

Claim Rejection – USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-24 (Canceled).

Claim 25-27, 29-31, 33-35, 37-39, 41-43, 45, 47-54, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vicknair et al. (Pub. No.: US 2003/0208421).

As per claim 25, 37, 49, and 52, Vicknair teaches receiving a single file including the check images from the capture bank (see paragraph 0020, the enhanced ECP is a single file including the check images; "transmitting bank" in the prior art is interpreted as the capture bank, because capture bank transmits the enhanced ECP file; also see paragraph 0045);

acquiring a cross-reference file from at least one of the paying bank and the capture bank (see paragraph 0055-0057; prior art teaches accessing or receiving a file containing an index of pointers from the "receiving bank"/paying bank' and then modify this file with set of pointers showing that the associated ECP images are stored in the electronic storage unit; the file containing index of pointers is interpreted as a cross-reference file, since the prior art file provides cross-reference of the location of the check images in the electronic storage);

using the cross-reference file to build a paying bank specific index while maintaining the check images in a substantially centralized storage system (see paragraph 0052-0057, especially paragraph 0052 and 0057 teach the embodiment of shared storage system; prior art teaches modifying a file containing an index of pointers to create a bank specific index for retrieval by the corresponding bank; see paragraph 0057, "when searching for an image, each institution, needs to only search their own index...in a further alternative, the index may be maintained at the site of the share database"; also see Fig. 6 item 600, "Common electronic storage of check images for institutions");

rendering the check images to the capture bank upon retrieval by the capture bank and to the paying bank only as necessary based on being retrieved by the paying bank using the paying bank specific index so that the check images are accessible upon retrieval by both the capture bank and the paying bank from the substantially centralized storage system (see paragraph 0054 and 0057, prior art teaches each bank has its own index for retrieval of check image stored in the common electronic storage and "when searching for an image, each institution, needs to only search their own index").

As per claim 26 and 53, Vicknair teaches the acquiring of the cross-reference file further comprises receiving the cross-reference file from the paying bank (see paragraph 0055-0057; prior art teaches accessing or receiving a file containing an index of pointers from the "receiving bank"/paying bank' and then modify this file with set of

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pointers showing that the associated ECP images are stored in the electronic storage unit; the file containing index of pointers is interpreted as a cross-reference file, since the prior art file provides cross-reference of the location of the check images in the electronic storage).

As per claim 27, 39, and 54, Vicknair teaches wherein the cross-reference file further comprises unique handles to identify the check images (see paragraph 0054-0055, the file containing the index of pointers, or the cross-reference file, is able to point out the location of a check image stored in a database; therefore, it is implied that the cross-reference file must comprises unique handles to identify each check image in the storage).

As per 29, 30, 31, 41, 42, 43, 50, Vicknair teaches wherein the rendering of the check images further comprises reading a check image from a first storage area for retrieval by the capture bank, and reading the check image from a second storage area for retrieval by the paying bank (see paragraph 0052 and 0057; producing duplicates of images retrievable by different entities is an obvious modification commonly understood by one of ordinary skill in the art).

As per claim 33, 34, 35, 45, 46, 47, 51, Vicknair teaches wherein the rendering of the check images further comprises reading a check image from the same storage area for retrieval by both the capture bank and the paying bank (see paragraph 0052 and 0057).

As per claim 38, Vicknair teaches wherein the computer program code further comprises instructions for parsing the cross-reference file (see paragraph 0054-0055, the file containing the index of pointers, or the cross-reference file, is able to point out the location of a check image stored in a database; therefore, it is implied that the cross-reference file must comprises unique handles to identify each check image in the storage; furthermore, the computer system in the prior art must be able parse or understand the cross-reference file in order to identify the location of each check image stored in the storage).

As per claim 56, Vicknair teaches wherein the databases further comprise an information interchange database (see paragraph 0052 and 0057, the shared database for storing check images can interchange information stored within and thus it is an information interchange database).

As per claim 57, Vicknair teaches wherein the databases further comprise a profiling database (paragraph 0055-0057, prior art appears to have the ability of creating bank specific index for each bank; profiling database in the present invention performs the same function according to the specification).

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As per claim 58, Vicknair teaches wherein the databases further comprises a permissions database created using an electronic cash presentment (ECP) file received from the capture bank (see paragraph 0051-0057).

Claim 28, 32, 36, 40, 44, 48, 55, are rejected under 35 U.S.C. 103(a) as being unpatentable over Vicknair et al. (Pub. No.: US 2003/0208421), in view of US Patent Number 5,784,610 to Copeland, III et al.

As per claim 28, 40, and 55, Vicknair does not teach wherein the unique handles further comprise check image management system (CIMS) keys.

Copeland teaches the unique handles further comprise check image management system (CIMS) keys (see column 7, line 4-11, and column 12, line 19-23).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the Vicknair reference with teaching from Copeland to include check image management system (CIMS) keys in the unique handles.

One of ordinary skill in the art would have been motivated to modify the Vicknair reference in order to provide specify the components of the unique handle.

As per claim 32 and 44, Vicknair teaches wherein the rendering of the check images further comprises reading a check image from a first storage area for retrieval by the capture bank, and reading the check image from a second storage area for retrieval by the paying bank (see paragraph 0052 and 0057; producing duplicates of images retrievable by different entities is an obvious modification commonly understood by one of ordinary skill in the art).

As per claim 36 and 48, Vicknair teaches wherein the rendering of the check images further comprises reading a check image from the same storage area for retrieval by both the capture bank and the paying bank (see paragraph 0052 and 0057).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO FU whose telephone number is (571)270-3441. The examiner can normally be reached on Mon-Fri/Mon-Thurs 11:30am-8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES KRAMER can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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